

CASES AND AUTHORITIES

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TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP)

UNITED STATES PATENT AND TRADEMARK OFFICE

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Foreword to the Fifth Edition

The Trademark Manual of Examining Procedure (TMEP) may be downloaded free of charge from the United States Patent and Trademark Office (USPTO) website at www.uspto.gov.

The Manual is published to provide trademark examining attorneys in the USPTO, trademark applicants, and attorneys and representatives for trademark applicants, with a reference work on the practices and procedures relative to prosecution of applications to register marks in the USPTO. The Manual contains guidelines for Examining Attorneys and materials in the nature of information and interpretation, and outlines the procedures which Examining Attorneys are required or authorized to follow in the examination of trademark applications.

Trademark Examining Attorneys will be governed by the applicable statutes, the Trademark Rules of Practice, decisions, and Orders and Notices issued by the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office, Commissioners, or Deputy Commissioners. Policies stated in this revision supersede any previous policies stated in prior editions, examination guides, or any other statement of Office policy, to the extent that there is any conflict.

Suggestions for improving the form and content of the Manual are always welcome. They should be addressed to:

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1201 Ownership of Mark

Under §1(a)(1) of the Trademark Act, 15 U.S.C. §1051(a)(1), an application based on use in commerce must be filed by the owner of the mark. A §1(a) application must include a verified statement that the applicant believes it is the owner of the mark sought to be registered. 15 U.S.C. §1051(a)(3)(A); 37 C.F.R. §2.33(b)(1). An application that is not filed by the owner is void. See TMEP §1201.02(b).

An application under §1(b) or §44 of the Act, 15 U.S.C. §1051(b) or §1126, must be filed by a party who is entitled to use the mark in commerce, and must include a verified statement that the applicant is entitled to use the mark in commerce and that the applicant has a bona fide intention to use the mark in commerce as of the application filing date. 15 U.S.C. §§1051(b)(3), 1126(d)(2) and 1126(e); 37 C.F.R. §2.33(b)(2). When the person designated as the applicant is not the person with a bona fide intention to use the mark in commerce, the application is void. See TMEP §1201.02(b).

In a §1(b) application, before the mark can be registered, the applicant must file an amendment to allege use under 15 U.S.C. §1051(c) (see TMEP §§1104 *et seq.*) or a statement of use under 15 U.S.C. §1051(d) (see TMEP §§1109 *et seq.*) that states that the applicant is the owner of the mark. 15 U.S.C. §§1051(b)(3)(A) and (B); 37 C.F.R. §§2.76(b)(1) and 2.88(b)(1).

In a §44 application, the applicant must be the owner of the foreign application or registration on which the United States application is based as of the filing date of the United States application. See TMEP §1005.

An application under §66(a) of the Trademark Act (*i.e.*, a request for extension of protection of an international registration to the United States under the Madrid Protocol), must be filed by the holder of the international

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Under Article 6*ter*, each member country shall communicate the list of emblems, official signs and hallmarks that it wishes to protect, and all subsequent modifications of its list, to the IB, who will transmit the communications to the other member countries. Within twelve months from receipt of the notification, a member country may transmit its objections, through the IB.

When the USPTO receives requests for protection under Article 6*ter* from the IB, they are assigned serial numbers in the “89” series code, *i.e.*, serial numbers beginning with the digits “89,” and are sometimes referred to as “non-registrations.” The USPTO searches its records for conflicting marks, but the requests are not subjected to a full examination by an examining attorney or published for opposition. Information about the designation is entered in the Office’s search records, and should be discovered in an examining attorney’s search.

Refusal Of Marks Because of an Article 6ter Designation

The Paris Convention requires that the United States refuse to register designations that have been deposited pursuant to Article 6*ter* and to which the United States has transmitted no objections. Depending on the nature and use of the mark, §§2(a) and 2(b) of the Trademark Act, 15 U.S.C. §§1052(a) and 1052(b), may bar registration of these marks. A refusal under §2(d) of the Trademark Act is **not** appropriate. The issue is not whether the marks are confusingly similar, but whether registration of the mark would violate §§2(a) or 2(b) of the Trademark Act.

For example, it may be appropriate for the examining attorney to refuse registration under §2(a) of the Act on the ground that the mark comprises matter that may falsely suggest a connection with a national symbol of a member country or an international intergovernmental organization. See TMEP §1203.03(e). Other §2(a) bases for refusal could also apply. See TMEP §§1203 *et seq.* It may be appropriate to refuse registration under §2(b) of the Act if the proposed mark comprises a flag, coat of arms or other similar insignia. See TMEP §1204. In some instances, it may be appropriate to refuse registration under §§1, 2 (preamble) and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052 and 1127, on the ground that the subject matter would not be perceived as a trademark. (For service mark applications, §3 of the Act, 15 U.S.C. §1053, should also be cited as a basis for refusal.)

1206 Refusal on Basis of Name, Portrait or Signature of Particular Living Individual or Deceased U.S. President Without Consent

Extract from 15 U.S.C. §1052. No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it ... (c) Consists of or comprises a name, portrait, or signature identifying a particular

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living individual except by his written consent, or the name, signature, or portrait of a deceased President of the United States during the life of his widow, if any, except by the written consent of the widow.

Section 2(c) of the Trademark Act, 15 U.S.C. §1052(c), bars the registration of a mark that consists of or comprises (whether consisting solely of, or having incorporated in the mark) a name, portrait or signature that identifies a particular living individual, or a deceased United States president during the life of his widow, except by the written consent of the individual or the president's widow.

Section 2(c) absolutely bars the registration of these marks on either the Principal Register or the Supplemental Register.

The purpose of requiring the consent of a living individual to the registration of his or her name, signature or portrait is to protect rights of privacy and publicity that living persons have in the designations that identify them.

University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc., 703 F.2d 1372, 1376, 217 USPQ 505, 509 (Fed. Cir. 1983), *aff'd* 213 USPQ 594 (TTAB 1982); *Canovas v. Venezia 80 S.R.L.*, 220 USPQ 660, 661 (TTAB 1983). See TMEP §1203.03 for a discussion of the right to control the use of one's identity, which underlies part of §2(a) as well as §2(c).

See TMEP §813 regarding when it is necessary for an examining attorney to inquire of the applicant as to whether a name, signature or portrait in a mark identifies a particular living individual, and regarding the entry of pertinent statements in the record for printing in the *Official Gazette* and on a registration certificate.

1206.01 Name, Portrait or Signature

Section 2(c) explicitly pertains to any name, portrait or signature that identifies a particular living individual, or a deceased president of the United States during the life of the president's widow.

To identify a particular living individual, a name does not have to be the person's full name. See *Ross v. Analytical Technology Inc.*, 51 USPQ2d 1269 (TTAB 1999) (registration of opposer's surname without consent prohibited by §2(c), where the record showed that because of opposer's reputation as an inventor in the field of electrochemical analysis, the relevant public would associate the goods so marked with opposer); *In re Sauer*, 27 USPQ2d 1073 (TTAB 1993), *aff'd per curiam*, 26 F.3d 140 (Fed. Cir. 1994) (BO, the recognized nickname of professional football and baseball star Bo Jackson, found to be so well known by the general public that use of the name BO in connection with sports balls would lead to the assumption that he was in some way associated with the goods or with applicant's business); *In re Steak and Ale Restaurants of America, Inc.*, 185 USPQ 447 (TTAB 1975)

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(PRINCE CHARLES found to identify a particular living individual whose consent was not of record); *Laub v. Industrial Development Laboratories, Inc.*, 121 USPQ 595 (TTAB 1959) (LAUB, for flowmeters, found to identify the holder of a patent for flowmeters, whose written consent was not of record); *Reed v. Bakers Engineering & Equipment Co.*, 100 USPQ 196, 199 (PTO 1954) (registration of REED REEL OVEN, for ovens, held to be barred by §2(c) without written consent of the designer and builder of the ovens, Paul N. Reed. “‘Name’ in §2(c) is not restricted to the full name of an individual but refers to any name regardless of whether it is a full name, or a surname or given name, or even a nickname, which identifies a particular living individual...”). Cf. *Société Civile Des Domaines Dourthe Frères v. S.A. Consortium Vinicole De Bordeaux Et De La Gironde*, 6 USPQ2d 1205, 1209 (TTAB 1988) (“Section 2(c) does not apply to surnames except in those cases where a particular individual is known by a surname alone.”)

Cases involving portraits include *In re McKee Baking Co.*, 218 USPQ 287 (TTAB 1983) (mark comprising a sign on which the portrait of a young girl appears below the words LITTLE DEBBIE); *In re Masucci*, 179 USPQ 829 (TTAB 1973) (mark comprising name and portrait of a deceased president of the United States, President Eisenhower); *Garden v. Parfumerie Rigaud, Inc.*, 34 USPQ 30 (Comm’r Pats. 1937) (marks comprising name and portrait of Mary Garden).

1206.02 Particular Living Individual or Deceased U.S. President

Section 2(c) applies to marks that comprise matter that identify living individuals; it does not apply to marks that comprise matter that identifies deceased persons, except for a deceased president of the United States during the life of the president’s widow. See *McGraw-Edison Co. v. Thomas Edison Life Insurance Co.*, 160 USPQ 685 (TTAB 1969), *vacated on other grounds*, 162 USPQ 372 (N.D. Ill. 1969) (opposition to the registration of THOMAS EDISON dismissed, the Board finding §2(c) inapplicable, as the particular individual whom the name identifies is deceased); *In re Masucci*, 179 USPQ 829 (TTAB 1973) (affirming refusal to register mark consisting of the name EISENHOWER, a portrait of President Dwight D. Eisenhower and the words PRESIDENT EISENHOWER REGISTERED PLATINUM MEDALLION #13, for greeting cards, on the ground that the mark comprises the name, signature or portrait of a deceased United States president without the written consent of his widow, under §2(c)).

The fact that a name appearing in a mark may actually be the name of more than one person does not negate the requirement for a written consent to registration, if the mark identifies, to the relevant public, a particular living individual or deceased United States president whose spouse is living. *In re Steak and Ale Restaurants of America, Inc.*, 185 USPQ 447 (TTAB 1975) (affirming refusal to register PRINCE CHARLES, for meat, in the absence of consent to register by Prince Charles, a member of the English royal family.

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“Even accepting the existence of more than one living ‘Prince Charles,’ it does not follow that each is not a particular living individual.”)

If it appears that a name, portrait or signature in a mark may identify a particular living individual but, in fact, the applicant devised the matter as fanciful, or believes it to be fanciful, a statement to that effect should be placed in the record. If appropriate, the statement that a name, portrait or signature does not identify a particular living individual will be printed in the *Official Gazette* and on the registration certificate. See TMEP §813. Additional relevant circumstances should also be explained. For example, if the matter identifies a certain character in literature, or a deceased historical person, then a statement of these facts in the record may be helpful; however, this information should not be printed in the *Official Gazette* or on a registration certificate.

Although a mark may have been devised to be fanciful or arbitrary and not to identify a particular living individual, it nevertheless may name or otherwise identify one or more living individuals. Whether consent to registration is required depends on whether the public would recognize and understand the mark as identifying the person. Therefore, if the person is not generally known, or well known in the field relating to the relevant goods or services, it may be that the mark would not constitute the identification of a particular person under §2(c), and consent would not be required. The Trademark Trial and Appeal Board noted as follows in *Martin v. Carter Hawley Hale Stores, Inc.*, 206 USPQ 931, 933 (TTAB 1979):

[Section] 2(c) was not designed to protect every person from having a name which is similar or identical to his or her name registered as a trademark. Such a scope of protection would practically preclude the registration of a trademark consisting of a name since in most cases there would be someone somewhere who is known by the name and who might be expected to protest its registration. Rather, the Statute was intended to protect one who, for valid reasons, could expect to suffer damage from another’s trademark use of his name. That is, it is more than likely that any trademark which is comprised of a given name and surname will, in fact, be the name of a real person. But that coincidence, in and of itself, does not give rise to damage to that individual in the absence of other factors from which it may be determined that the particular individual bearing the name in question will be associated with the mark as used on the goods, either because that person is so well known that the public would reasonably assume the connection or because the individual is publicly connected with the business in which the mark is used.

In *Martin*, the Board held that §2(c) did not prohibit registration of NEIL MARTIN for men’s shirts, where the individual, although well known in his

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own professional and social circles, failed to establish that he was so famous as to be recognized by the public in general or that he is or ever was connected with the clothing field.

In *Krause v. Krause Publications, Inc.*, 76 USPQ2d 1904 (TTAB 2005), evidence was found sufficient to establish that the cancellation petitioner was publicly connected with the fields of numismatics, car collecting and publishing, such that a connection between petitioner and the mark KRAUSE PUBLICATIONS would be presumed by people who have an interest in these fields. Thus, the mark was unregistrable for magazines featuring antique automobiles and numismatics, conducting trade shows and award programs featuring coins, and other related goods and services. However, the mark was found registrable for “entertainment services in the nature of competitions and awards in the field of cutlery,” because petitioner had not demonstrated that he was publicly connected with the field of cutlery, or that he is so well known by the general public that a connection between petitioner and the mark would be presumed with respect to these services. *See also Ross v. Analytical Technology Inc.*, 51 USPQ2d 1269 (TTAB 1999) (evidence found sufficient to establish that opposer Dr. James Ross was publicly connected with the electrochemical analysis equipment field and that use of the name ROSS in connection with equipment in that field would lead to the assumption that opposer was in some way associated with the goods); *In re Sauer*, 27 USPQ2d 1073 (TTAB 1993), *aff’d per curiam*, 26 F.3d 140 (Fed. Cir. 1994) (BO, the recognized nickname of professional football and baseball star Bo Jackson, found to be so well known by the general public that use of the name BO in connection with sports balls would lead to the assumption that he was in some way associated with the goods or with applicant’s business); *Fanta v. Coca-Cola Co.*, 140 USPQ 674 (TTAB 1964) (dismissing a petition to cancel registrations of FANTA for soft drinks and syrup concentrate, the Board noting no use by the petitioner, Robert D. Fanta, of his name in connection with the sale of soft drinks, nor any indication that petitioner had attained recognition in that field); *Brand v. Fairchester Packing Co.*, 84 USPQ 97 (Comm’r Pats. 1950) (affirming dismissal of a petition to cancel the registration of ARNOLD BRAND, for fresh tomatoes, the Commissioner finding nothing in the record to indicate that the mark identified the petitioner, Arnold Brand, an attorney specializing in patent and trademark matters, with the tomato business, or that use of the mark would lead the public to make such a connection).

To support a refusal under §2(c) as to a particular class in an application, it is not necessary to demonstrate that the individual is publicly connected with all the goods or services listed in the class. It is enough to show that the individual is publicly connected with at least some of the goods/services in the class. *Krause, supra*.

SUBSTANTIVE EXAMINATION OF APPLICATIONS**1206.03 Consent of Individual or President's Widow Required****1206.03(a) Consent Must Be Written Consent to Registration**

When a name, portrait or signature in a mark identifies a particular living individual, or a deceased president of the United States during the life of his widow, the mark can be registered only if the written consent of the individual, or of the president's widow. The consent must be a written consent to the registration of the identifying matter as a trademark.

Consent to use of a mark does not constitute consent to register. *Krause v. Krause Publications, Inc.*, 76 USPQ2d 1904 (TTAB 2005); *Reed v. Bakers Engineering & Equipment Co.*, 100 USPQ 196, 199 (PTO 1954); *Garden v. Parfumerie Rigaud, Inc.*, 34 USPQ 30, 31 (Comm'r Pats. 1937) (granting petition to cancel registrations of marks that named and portrayed the petitioner, Mary Garden, who, although she had consented to the use of her name and portrait in connection with a particular perfume, had not given written consent to register the marks for perfumes and other cosmetic items. "Permission to use one's name and portrait in connection with a specified item of merchandise falls far short of consent to register one's name and portrait as a trade mark for such merchandise generally.") Consent to *register* a mark that makes no reference to consent to *use* is acceptable; the Office has no authority to regulate use of a mark.

Written consents for minors may be given by their guardians.

1206.03(b) Implicit Consent

When a particular individual identified by matter in a mark is also the person who signed the application, then his or her consent to registration will be presumed. *Alford Mfg. Co. v. Alfred Electronics*, 137 USPQ 250 (TTAB 1963), *aff'd*, 333 F.2d 912, 142 USPQ 168 (C.C.P.A. 1964) ("The written consent to the registration of the mark 'ALFORD' by Andrew Alford, the individual, is manifested by the fact that said person executed the application...."); *Ex parte Dallieux*, 83 USPQ 262, 263 (Comm'r Pats. 1949) ("By signing the application, the applicant here obviously consents....").

The mere incorporation of a business and consent to the business's use of the mark does not constitute implied consent to the *registration* of the mark. *Krause v. Krause Publications, Inc.*, 76 USPQ2d 1904 (TTAB 2005) (Cancellation petitioner did not give implied consent to register when he incorporated the business, sold his stock in the business and pledged his assets to finance expansion and acquisitions, and acquiesced in the corporation's use of the mark for 50 years, where there was no evidence that petitioner expressly stated that the mark was the property of the corporation and petitioner did not agree to refrain from use of the name in any subsequent business); *In re New John Nissen Mannequins*, 227 USPQ 569 (TTAB 1985) (consent to register not implied from appearance of the name

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“John Nissen” in a deed of incorporation of applicant’s predecessor, nor from existence of foreign registrations incorporating the name). *Compare, In re D.B. Kaplan Delicatessen*, 225 USPQ 342, 344 (TTAB 1985) (consent to the use and registration of the mark D. B. KAPLAN’S DELICATESSEN, for restaurant services, found to be implicit in the terms of a “buy-out” agreement that relinquished all property rights in the name and forbade its use by the named party in any subsequent business).

An applicant does not have to submit a new consent if a consent to register is already part of the record in the file of a valid registration for a mark comprised in whole or in part of the same name, portrait or signature for the same goods or services. In this situation, the applicant only has to claim ownership of that existing registration. If an applicant has submitted a consent to register in an application that has not matured to registration, a new consent is not required for pertinent co-pending applications, but the applicant must submit a copy of the consent for each pending application. *In re McKee Baking Co.*, 218 USPQ 287 (TTAB 1983) (applicant’s claim of ownership of a prior registration that includes a consent to register in the record held sufficient for purposes of complying with the consent requirement of the Act); 37 C.F.R. §2.193(a).

See TMEP §813 regarding a statement of consent of a living individual to the registration of his or her name or likeness.

1207 Refusal on Basis of Likelihood of Confusion, Mistake or Deception

Extract from 15 U.S.C. §1052. No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it ... (d) Consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive....

Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), is the statutory basis for a refusal to register due to likelihood of confusion with another mark. Section 2(d) applies to both the Principal and the Supplemental Register.

1207.01 Likelihood of Confusion

In the *ex parte* examination of a trademark application, a refusal under §2(d) is normally based on the examining attorney’s conclusion that the applicant’s mark, as used on or in connection with the specified goods or services, so resembles a *registered* mark as to be likely to cause confusion. (See TMEP